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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,008	01/20/2004	Richard Baker	09991-133001	9638
26178 7590 09/24/2008 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
LEFT, STEVEN N				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
09/24/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/761,008

Applicant(s)

BAKER ET AL.

Examiner

STEVEN LEFF

Art Unit

1794

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
b) ☐ They raise the issue of new matter (see NOTE below);
c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-11 and 13-40.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Drew E Becker/
Primary Examiner, Art Unit 1794

Continuation of 11, does NOT place the application in condition for allowance because: Applicants amendments to independent claim 1 has changed the claim dependency with respect to dependent claims 5-11, and 13-26, thus raising new issues which would require further consideration and/or search since limitations now appear in independent claim 1 which were previously not present. Applicants deletion of subject matter from claim 1 would raise new issues which would require further consideration and/or search. With respect to applicants argument that Willcocks fails to teach processing the food product to reduce gravity flowability, that the food product has a gravity flowability, and with respect to the lateral image bleed it is noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For example, Young teaches a certain concept, specifically the desire to provide applicant's inventive aspect of providing high resolution images on decorated edible substrates of different viscosities thus producing an edible substrate which would be more appealing to a larger group of people, since the reference states that the edible substrate is ice cream, boiled sugar or chocolate. Willcocks et al. is relied upon to teach that the edible substrate is treated by "drying or fixing the image after the printing step", where it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." (see MPEP 2144.01) In the instant case, one of ordinary skill in the art would view that the "fixing step" could be meant to represent cooling or freezing to a specific temperature in order to keep the ice cream from melting and/or providing chocolate or boiled sugar in its well known consumed form of a solid. Therefore although Young does not disclose specifically allowing the product to cool to solidify the surface, one of ordinary skill in the art would be motivated to combine the teachings of Young and Willcocks et al. since Young does teach printing on ice cream (col. 6 line 8+), where if not kept cool ice cream will melt. In addition, cooling would allow the product to solidify, thereby allowing the image to maintain its high resolution since the melted material is in a set state due to lower the temperatures which lowers the surface energy as is taught by Willcocks et al. (pg. 22 line 24+). Thus it would have been obvious to one of ordinary skill in the art to teach cooling the food product or that the food product is solidified in order to maintain the resolution of the image since the melted material would cause the ink to "run" or "bleed" and thus in the instant case the "fixing step" is taken to mean cooling or freezing to a specific temperature in order to keep the ice cream from melting, or the product or coating from "running" or "bleeding" in the case of boiled sugar or chocolate.

In response to applicant's argument neither Willcocks nor Young teach the desired image bleed it is noted that applicant has not provided evidence or convincing arguments to support their position, other than to simply disagree with the position of the Office where one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). However, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding "a lateral image bleed of about 10% or less in 10 minutes" must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001". It is further noted that as was clearly set forth in the previous Office action the degree that an image bleeds is dependant upon different factors, such as the surface characteristics of the substrate and the media used, as well as the amount of time it takes the image to dry after being applied. In addition, Willcocks et al. teach an ink composition, which includes alcohol for its art recognized and applicant's intended function of reducing the bleed of the ink once applied to the substrate, where Willcocks et al. further teach the addition of alcohol to the media composition as part of the carrier so that the image will dry quickly once printed, (pg. 28 line 24+) and an image resolution of 200 dpi after the image has been applied to the edible substrate using an ink jet printer. Therefore since Willcocks et al. teach that alcohol may be included in the media for its art recognized and applicant's intended function of achieving a desired resolution, and since the referenced method and materials meet those of the instant claims, it would be expected that the resulting product, an edible substrate with an image applied, would thus meet the limitations of the claims, as it would not have involved an inventive step for one of ordinary skill in the art to have selected a specific "image bleed" value for use in the invention as disclosed since both Willcocks and Young teach high resolution images where the image bleed value directly affects the overall resolution of the image as a function of the different factors described above.